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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,192	05/24/2000	Ravi V. Condamoor	NH-1	5445

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SANTA CRUZ, CA 95062-5319

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,192

Applicant(s)

CONDAMOR ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 30-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-29 is/are rejected.
- 7) ☐ Claim(s) 12, 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicants' communication filed on March 8, 2004. Amendments to claims 1, 25, 30, 33 and 34 have been entered. Rejections made under 35 USC § 112, first paragraph and under 35 USC § 101 in the last office action are withdrawn in view of the amendments and persuasive arguments. Claims 1-34 are pending in the application. Claims 30-34 are subject to restriction/election as discussed below. During a telephone conversation with Mr. Stuart T Auvinen on March 4, 2005 an oral election was made to prosecute claims 1-29 drawn to Group I. Claims 30-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicants are respectfully advised to cancel the non-elected claims in response to this office action. Claims 1-29 have been examined. The election/restrictions, rejections and response to arguments are stated below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-29, drawn to a system, computer program product and a method for a multi-attribute valuing system, classified in class 705, subclass 37.

II. Claims 30-32, drawn to a computer-implemented tool for finding an optimally - specified product for purchase, classified in class 705, subclass 37.

III. Claims 33-34, drawn to a method for dynamically augmenting a product with attributes that are most valued by prospective buyers, classified in class 705, subclass 37.

3. Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a system, computer program product

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and a method for a multi-attribute valuing system, whereas invention II relates to a computer-implemented tool for finding an optimally specified product for purchase. The steps of the two inventions are clearly different and distinct in scope and utility as further evident from the preamble of the claims to the two inventions. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper even though they are classified in the same class and subclass.

Inventions I and III are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a system, computer program product and a method for a multi-attribute valuing system, whereas invention III relates to a computer-implemented tool for finding an optimally specified product for purchase. The steps of the two inventions are clearly different and distinct in scope and utility as further evident from the preamble of the claims to the two inventions. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III, restriction for examination purposes as indicated is proper even though they are classified in the same class and subclass.

Inventions III and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III relates to a computer-implemented tool for finding an optimally specified product for purchase, whereas invention II relates to a computer-implemented tool for finding an optimally specified product for purchase. The steps of the two

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inventions are clearly different and distinct in scope and utility as further evident from the preamble of the claims to the two inventions. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group II, restriction for examination purposes as indicated is proper even though they are classified in the same class and subclass.

4. During a telephone conversation with Mr. Stuart T Auvinen on March 4, 2005 to request an oral election to the above restriction requirement, a provisional election was made to prosecute claims 1-29 of Group I. Claims 30-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11 and 14-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paskowitz (US Patent 6,377,937 B1).

With reference to claim 1, Paskowitz discloses multi-attribute valuing system, comprising: a buyer attribute-input to a computerized system for receiving a plurality of buyer delta values for a product, each buyer delta value indicating a higher or a lower true-value that the buyer places on the product when modified by an attribute associated with the buyer delta value; a seller attribute-input to a computerized system for receiving a plurality of seller delta

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values for the product, each seller delta value indicating a higher or a lower true-value that the seller places on the product when modified by the attribute associated with the seller delta value; an attribute manager, receiving the attributes and buyer delta values in a computer readable format from the buyer and the seller delta values in a computer-readable format from the seller, for creating and managing attribute trees stored on a computer-readable medium, each attribute tree specifying dependencies among the attributes of the product, the attributes associated with buyer delta values that adjust a true-value of the product; an attribute-tree analyzer, receiving a buyer attribute tree in a computer-readable format for the buyer and a seller attribute tree in a computer-readable format from the seller for the product, for comparing the buyer delta values with the seller delta values for a plurality of the attributes that modify the product, the attribute-tree analyzer selecting an optimal specification of the product, the optimal specification including a series of the attributes; and a product specifier, coupled to the attribute-tree analyzer, for reporting to the seller the series of the attributes for the optimal specification of the product, whereby the optimal specification of the product is determined by analyzing the buyer delta values specified by the buyer and the seller delta values that adjust the true-value of the product (See Paskowitz Abstract, Column 2 lines 55 – Column 5 line 20, Column 6 lines 32-65, claims 1-3).

With reference to claim 14, Paskowitz discloses a computer-program product comprising: a computer-usable medium having computer-readable program code means embodied therein for indicating differential values of products in a product family, the computer-readable program code means in the computer-program product comprising: attribute means for storing product-attributes that specify products within the product family, the

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products varying according to product-attributes; input means for receiving delta values from a user, the delta values representing differences in values of products in the product family, the products varying according to the product attributes, the delta values representing differences in value perceived by the user for the product specified by the product-attributes; and value attach means, coupled to the input means and to the attribute means, for attaching the delta values to the product-attributes to form a user attribute-store, whereby the user attribute-store indicates differences in values perceived by the user for products in the product family that vary in specification according to the product attributes (See Paskowitz Abstract, Column 2 lines 55 – Column 5 line 20, Column 6 lines 32-65, claims 1-3).

With reference to claim 25, Paskowitz discloses a computer-implemented method for selecting a product for sale to a trading partner comprising: receiving in a computer-readable format a selection of a base product from the trading partner; receiving a list of attributes in a computer-readable format for the base product from the trading partner; for each attribute in the list of attributes, receiving a delta value from the trading partner for the attribute, the delta value being in a computer-readable format and indicating an additional value the trading partner places on the product when the base product is modified by the attribute, the delta values being trading partner specified; selecting as a selected product the product modified by a subset of the attributes in the list of attributes, the subset of the attributes including attributes wherein a sum of the delta values for attributes in the subset of the attributes is a selected sum; offering the selected product to the trading partner for sale to the trading partner; whereby the product sold is selected using a selected sum of the delta values of the attributes specified by the trading

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partner (See Paskowitz Abstract, Column 2 lines 55 – Column 5 line 20, Column 6 lines 32-65, claims 1-3).

With reference to claims 2-11, 15-24 and 26-29, the features in these claims are either inherent in the disclosure of Paskowitz or are old and well known. These features help further refine the selection and matching process and provide an efficient means to generate a product/service that is compatible with the users' needs and preferences. If not inherent it would have been obvious to one of ordinary skill in the art to include these features to the disclosure of Paskowitz. The combination of disclosures would have helped the user by generating a product/service that is compatible with the users' needs and preferences.

Allowable Subject Matter

7. Claims 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments have been considered but are moot in view of new grounds of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Walker et al (US Patent 6,085,169) (July 4, 2000) Conditional Purchase Offer Management System

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(b) Walker et al (US Patent 6,553,346 B1) (April 22, 2003) Conditional Purchase Offer (CPO) Management System for Packages

© Walker et al (US Patent 5,794,207) (August 11, 1998) Method and Apparatus for Cryptographically assisted Commercial Network System Designed to Facilitate Buyer-Driven Conditional Purchase Offers

(d) Weschler (US Patent 6,757,720 B1) (June 29, 2004) Profile Service Architecture

(e) Kumar et al (US Patent 6,343, 287 B1) (January 29, 2002) External Data Store Link for Profile Service

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

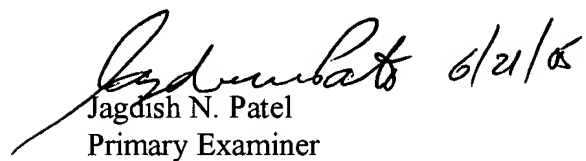
N. Subramanian

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June 18, 2005

 6/21/05
Jagdish N. Patel
Primary Examiner